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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/630,022	07/30/2003	Daniel Edward Bowen III	DN2003-127	7760

7590 01/03/2006

The Goodyear Tire & Rubber Company  
Patent & Trademark Department  
D/823  
1144 East Market Street  
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EXAMINER

COSTALES, SHRUTI S

ART UNIT PAPER NUMBER

1714

DATE MAILED: 01/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action  
Before the Filing of an Appeal Brief**

Application No.

10/630,022

Applicant(s)

BOWEN ET AL.

Examiner

Shruti S. Costales

Art Unit

1714

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 14 December 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.  
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☒ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: 1-20.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See attachment.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). \_\_\_\_\_  
13. ☐ Other: \_\_\_\_\_.

Continuation of 3. NOTE: The applicant has amended claim 1 to add the limitation "wherein the low molecular weight end-group functionalized diene rubber is selected from the group consisting of functionalized butadiene rubbers, functionalized polyisoprene rubbers, functionalized styrene-butadiene rubbers, and functionalized styrene-isoprene rubbers, wherein the cement of the conventional rubbery polymer is comprised of the conventional rubbery polymer and an organic solvent", wherein the Examiner cannot find support for "functionalized polyisoprene rubbers" and "functionalized styrene-isoprene" rubbers in the original disclosure filed by the applicant. Further, it is to be noted that the Examiner will have to conduct a new search for the quoted limitation. Therefore, applicant's amendments to the claims filed on December 14, 2005 raise new issues that will require a new prior art search and said amendments further raise new matter issues.

**Attachment to Advisory Action**

1. Applicant's arguments filed December 14, 2005 have been fully considered but they are not persuasive.

Specifically, applicant argues that (a) the mixing temperature is not within the claimed range, and (b) dispersing into the cement of a conventional rubbery polymer is not disclosed by the references.

With respect to the argument in (a), Lin discloses that the various components of sulfur-vulcanizable elastomeric compound are added at a temperature of 165° C to about 200° C and in a final mixing step the temperature is within a preferred range of about 40° C to about 120° C (Col. 7, lines 60-67 and Col. 8, lines 1-41). Therefore, at least the final mixing step temperatures overlap the presently claimed temperature range. Further, applicant's claim 1 is not limited in scope to the mixing of the disclosed components only because of the transitional phrase "comprising", which is open-ended. See M.P.E.P. § 2111.03. Further, the transitional term "comprising is inclusive or open-ended and does not exclude additional, unrecited elements or method steps. See, e.g., *Invitrogen Corp. v. Biocrest Mfg., L.P.*, 327 F.3d 1364, 1368, 66 USPQ2d 1631, 1634 (Fed. Cir. 2003) and *Genentech, Inc. v. Chiron Corp.*, 112 F.3d 495, 501, 42 USPQ2d 1608, 1613 (Fed. Cir. 1997).

With respect to the argument in (b), Asahara, which is drawn to a block copolymer composition (Col. 1, lines 7-16), discloses that the molecular weight of a rubber polymer treated with tetramethoxysilane has a molecular weight of 70,000 to 210,000 (Col. 14, lines 63-67; Col. 15, lines 1-5; and Table 2). Although Asahara

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discloses block copolymers, both Lin and the present invention are drawn to copolymers generally. Asahara's block copolymers are a specific type of copolymers not necessarily excluded by the present claims. Further, it is to be noted that Asahara is used as a teaching reference, and therefore, it is not necessary for this secondary reference to contain all the features of the presently claimed invention, *In re Nievelt*, 482 F.2d 965, 179 USPQ 224, 226 (CCPA 1973) and *In re Keller*, 624 F.2d 413, 208 USPQ 871, 881 (CCPA 1981). Rather this reference teaches a certain concept, namely, that the use of a specific molecular weight of a rubber copolymer treated with tetramethoxysilane has high holding power and good heat resistance, and in combination with the primary reference, discloses the presently claimed invention.

It is the Examiner's position that the presently claimed invention is obvious as set forth in paragraphs 5-7 of the office action mailed November 8, 2005.

Shruti S. Costales  
December 23, 2005

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